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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,128	06/25/2004	James Surjan		7387

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PAULEY PETERSON & ERICKSON
2800 W. HIGGINS ROAD
SUITE 365
HOFFMAN ESTATES, IL 60169

EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1765

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05/24/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/500,128	Applicant(s) SURJAN, JAMES	
	Examiner ROBERT SELLERS	Art Unit 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-31, 35, 37-43 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-31, 35, 37-43 and 47-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>28 March 2011</u> . | 6) <input type="checkbox"/> Other: _____ |

1. The 35 U.S.C. 112, first and second paragraphs, rejections of claims 44-46 have been rendered moot by their cancellation in the amendment filed April 26, 2011.
2. The 35 U.S.C. 103(a) rejections over Surjan et al. '678 and '458 as well as Surjan et al. Patent Nos. 6,402,434 and 6,416,236 are withdrawn based on the statement of common ownership set forth on page 9 the last paragraph of the amendment.

The text of the basis for nonstatutory obviousness-type double patenting and section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejections mailed March 25, 2011 and November 17, 2006, respectively.

Claims 20-31 and 37-54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Surjan et al. Patent Nos. 6,291,555 (Surjan et al. '555, claims 1-19), 6,403,678 (claims 1, 2 and 8-10) or 6,420,458 (claims 1-12 and 23-26) in view of (Gienau et al. Patent No. 6,645,340 and Hartman et al. Patent No. 5,962,602) and (Coleman et al. Patent No. 6,166,849 and Morgan et al. Patent No. 5,681,128).

3. The limitations of canceled claims 32 and 33 requiring the presence of a reactive terminal end portion-containing diluent into the epoxy compound at a weight ratio of epoxy compound:diluent of from 65:10 to 90:0.5 have been inserted into independent claim 20, thereby necessitating the incorporation of Gienau et al. and Hartman et al. teaching the inclusion of a reactive diluent such as cyclohexanedimethanol diglycidyl ether (Gienau et al., col. 3, line 24) at a reactive diluent of from 50:50 to 99:1

(Gienau et al., col. 3, lines 37-39).

4. The three terminal disclaimers filed April 26, 2011 have been disapproved since application no. 12/190,372 on the Revocation and Grant of Power of Attorney filed April 26, 2011 does not match instant application no. 10/500,128 on the terminal disclaimers.

Claims 20-31, 35, 37-43 and 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surjan et al. Patent No. 6,291,555 in view of (Gienau et al. Patent No. 6,645,340 and Hartman et al. Patent No. 5,962,602) and (Coleman et al. Patent No. 6,166,849 and Morgan et al. Patent No. 5,681,128).

5. The limitations of canceled claims 32 and 33 requiring the presence of a reactive terminal end portion-containing diluent into the epoxy compound at a weight ratio of epoxy compound:diluent of from 65:10 to 90:0.5 have been inserted into independent claim 20, thereby necessitating the incorporation of Gienau et al. and Hartman et al. teaching the inclusion of a reactive diluent such as cyclohexanedimethanol diglycidyl ether (Gienau et al., col. 3, line 24) at a reactive diluent of from 50:50 to 99:1 (Gienau et al., col. 3, lines 37-39).

6. The statement of common ownership is inapplicable to Surjan et al. '555. Surjan et al. '555 qualifies as prior art under 35 U.S.C. 103(a) as a 102(a) reference since the patent date of September 18, 2001 antedates the effective filing date of the instant application of December 28, 2001.

The arguments filed April 26, 2011 have been considered but are unpersuasive.

7. The viscosity for the epoxy resin first part of Surjan et al. '555 ranges widely by an order of magnitude of from about 5 to about 50 million centipoise at 25°C (col. 3, lines 63-64). It would have been obvious to optimize the viscosity of Surjan et al. '555 within such broad parameters by the use of the epoxy-terminated reactive diluents of Gienau et al. and Hartman et al. (col. 3, lines 14-22) while also mitigating cracking, shrinkage and creep, enhancing dimensional stability, toughness and high load values, and reducing curing times (Gienau et al., col. 3, lines 6-15).

Claims 20-31, 35, 37-43 and 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman et al., Hartman et al. Morgan et al., Gienau et al. and Japanese Patent No. 2000-154359.

8. The rejection has been refined to address newly limited independent claim 20 requiring the presence of a reactive terminal end portion-containing diluent into the epoxy compound at a weight ratio of epoxy compound:diluent of from 65:10 to 90:0.5 and at least one aliphatic amine which is broader than the originally claimed plurality of aliphatic amines since a single aliphatic amine is now within its purview.

9. The Japanese patent reports a two-pack anchoring adhesive (translation, page 1, paragraph 2) comprising (Patent Abstracts of Japan) a component (A) of (i) a bisphenol epoxy resin and (ii) a reactive diluent such as 1,6-hexanediol diglycidyl ether (page 2, paragraph 18) in an epoxy resin:reactive diluent weight ratio of from 10:1 to 7:3, or from 9% to 30% by weight overlapping the claimed converted weight ratio of from 0.5 to 13.3% by weight, and component (B) of (iii) a heterocyclic diamine such as Epomate LX-3S (page 5, paragraph 47, a heterocyclic diamine as shown in the LookChem webpage within the claimed aliphatic amine according to page 8, lines 11-12 of the instant specification, and (iv) a polyamidoamine also within the claimed aliphatic amine according to page 8, line 20. The weight ratio of epoxy component A:amine component B is from 100:20-80, or from 1.25:1 to 5:1. A hardening accelerator is suitable according to page 3, paragraph 33, lines 4-5.

The claimed tertiary amine is not recited.

10. It would have been obvious to use the 2,4,6-tris(dimethylaminomethyl)phenol of Hartman et al. as the hardening accelerator of the Japanese patent in order to reduce the curing time and/or the curing temperature.

The amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL** (MPEP § 706.07(a)). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)
Monday to Friday, 9:30 to 6:00

/Robert Sellers/
Primary Examiner
Art Unit 1765

rs
5/16/2011